

REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

An RCE is being filed concurrently herewith this response. Therefore, kindly enter and consider the after final response submitted September 3, 2004.

I. CLAIM STATUS & AMENDMENTS

Claims 1, 3, and 5 were pending in this application when last examined.

Claims 1, 3, and 5 are finally rejected in the final Office Action dated June 3, 2004.

Due to entry of the after final response submitted September 3, 2004, claims 1, 3, 5, and 6 would have been pending in this application. However, the present amendment cancels claims 5 and 6 without prejudice or disclaimer thereto. Applicants reserve the right to file a continuation or divisional application on any cancelled subject matter.

Claims 1 and 3 have been amended to be in "consisting essentially of" format. Support for these amendments can be found in the specification, for example, at page 2, lines 20-24 and in original claim 5.

Therefore, no new matter has been added by this amendment.

Claims 1 and 3 are now pending in this application.

II. REJECTIONS UNDER 35 U.S.C. §§ 102 & 103

A. Sato (claim 1)

Claim 1 remains rejected under 35 U.S.C. § 102(e), as anticipated by or, in the alternative, as obvious under 35 U.S.C. § 103(a) over Sato et al., U.S. Patent No. 5,753,727. See item 1 on page 2 and item 5 on pages 2-4 of the final Office Action dated June 3, 2004. See also item 5 on page 2 of the Advisory Action.

This rejection is respectfully traversed for the same reasons set forth on pages 3-5 of the response filed September 3, 2004 and for the following reasons, especially as applied to the amended claims which exclude the presence of large amounts of uncarboxylated chloroprene rubber.

Claim 1 calls for a synthetic chloroprene rubber adhesive composition consisting essentially of: (1) 100 parts by weight of carboxylated synthetic chloroprene rubber; and (2) 1-30 parts by weight of chlorinated polypropylene and/or chlorinated polypropylene derivatives. Therefore, the amended claims, which are drawn to an adhesive which "consists essentially of," exclude the presence of large amounts of uncarboxylated chloroprene rubber, because the presence of large amounts of uncarboxylated chloroprene rubber would substantially effect the basic novel properties of the claimed adhesive.

In the sentence bridging pages 2-3 of the final Office Action, the Examiner noted that the claims do not exclude the presence of uncarboxylated chloroprene, whether at a 50:50 proportion or otherwise. However, the present amendment obviates this concern, because the amended claims, which are drawn to an adhesive which "consists essentially of," excludes the presence of large amounts of uncarboxylated chloroprene rubber.

In contrast, Sato discloses an adhesive composition wherein uncarboxylated chloroprene rubber or a 50:50 combination of uncarboxylated chloroprene rubber and carboxylated chloroprene rubber are the main component. Thus, the adhesive composition in Sato contains 50% or more of uncarboxylated chloroprene.

Furthermore, the amendment to the claims also requires that carboxylated synthetic chloroprene be the main ingredient. Sato lacks a suggestion to use carboxylated chloroprene rubber as the main ingredient, because Sato does not discuss the effect of carboxylated chloroprene rubber on adhesive properties as discussed on page 4 of the prior response. In fact, Sato can be said to teach-away from the claimed composition, in that Sato's composition contains uncarboxylated chloroprene, which is excluded from the claimed invention.

Thus, the amended claims exclude the presence of large amounts of uncarboxylated chloroprene rubber as disclosed in Sato. Sato also fails to disclose or suggest the use of carboxylated chloroprene rubber as the main ingredient of an adhesive composition.

Therefore, in view of the above, rejection of claim 1 under 35 U.S.C. §§ 102(e) and 103(a) is untenable, and should be withdrawn.

B. Sato in view of the admitted prior art (claims 3 and 5)

Claims 3 and 5 remain rejected under 35 U.S.C. § 103(a) as obvious over Sato in view of the admitted state of the prior art. See item 3 on page 2 and item 5 on pages 2-4 of the final Office Action dated June 3, 2004. See also item 5 on page 2 of the Advisory Action.

This rejection is respectfully traversed for the same reasons noted above. Again, the amended claims contain the term “consisting essentially of”, and thus, exclude the presence of large amounts of uncarboxylated chloroprene rubber. Therefore, the rejection of claims 3 and 5 under 35 U.S.C. § 103(a) is untenable, and should be withdrawn.

C. Admitted State of Prior Art in view of Smith, Kirk-Othmer, optionally in view of Sato and/or JP1-153781 (claims 1, 3, and 5)

Claims 1, 3, and 5 remain rejected under 35 U.S.C. § 103(a) as obvious over the admitted state of the prior art in view of Smith, U.S. Patent No. 3,347,847 and/or Kirk-Othmer Encyclopedia of Chemical Technology, and optionally further in view of Sato and/or the Abstract of JP1-153781. See item 4 on page 2 and item 5 on pages 2-4 of the final Office Action. See also item 5 on page 2 of the Advisory Action.

This rejection is respectfully traversed for the same reasons discussed above, and for the reasons noted below.

The deficiencies of Sato and the alleged admitted state of the prior art have been discussed above previously and are reiterated herein.

As discussed in the previous response, Smith fails to suggest the use of carboxylated chloroprene rubber as an adhesive against polypropylene, let alone as the main ingredient in such adhesive. Instead, Smith merely discloses a process for isolating a stable synthetic carboxylated chloroprene rubber, but fails to discuss its adhesive properties against polypropylene.

The Kirk-Othmer Encyclopedia of Chemical Technology discloses that carboxylated chloroprene rubber has good adhesive strength and high temperature cohesive strength. However, this reference fails to disclose or suggest the specific combination of the claimed invention, namely the use of carboxylated chloroprene as the main ingredient.

JP1-153781 only discloses one liquid type of a conventional self-crosslinking chloroprene adhesive including chlorinated polypropylene. The addition of chlorinated polypropylene is considered known in the art. However, as demonstrated in the specification, the present invention actually increases the adhering properties of the conventional adhesive compositions including chlorinated polypropylene. Also, the cited reference fails to disclose or suggest the specific combination of the claimed invention, wherein carboxylated chloroprene is used as the main ingredient.

In view of the above, the rejection of claims 1, 3 and 5 under 35 U.S.C. § 103 is untenable and should be withdrawn.

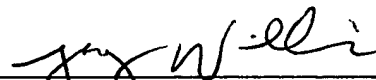
CONCLUSION

In view of the foregoing amendments and remarks, the present application is in condition for allowance and notice to that effect is hereby requested.

If it is determined that the application is not in condition for allowance, the Examiner is invited to telephone the undersigned attorney to expedite prosecution of the present application.

Respectfully submitted,

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October 4, 2004

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